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SAMPLE, DAVID R

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL M. MARTELLI

Appeal 2009-014638
Application 10/677713
Technology Center 1700

Before PETER F. KRATZ, KAREN M. HASTINGS, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-4, 6, 8-10, 13, and 15-18. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellant's claimed invention is directed to a molded thermoplastic product that has an outer surface including a matte finish with an etched pattern having depressions of a specified size.

As background to their disclosed invention, Appellants state that “[modern consumer products demand eye-catching attention;” and [p]roducers of consumer products compete for available shelf space in retail businesses” (Spec. 1, ll. 18-19). Appellants indicate that they address this need with their “molded thermoplastic product having an outer surface with a matte finish, wherein the matte finish is produced by a combination of an etched mold in which the product is molded to physically affect the outer surface and a colorant compounded in the thermoplastic to chemically affect the outer surface” (Spec. 2, 12-16). The outer surface finish is claimed to add both a tactile texture in addition to a matte finish appearance to the product (Spec. 2, ll. 7-11). A frost colorant is present in the thermoplastic resin in a specified amount that is used to add diffused translucency to the product (Spec. 4, ll. 9-30).

Claim 1, the sole independent claim on appeal, is illustrative and reproduced below:

1. A molded thermoplastic product comprising a thermoplastic resin molded to have an outer surface having a matte finish with an etched pattern having depressions ranging from about 0.1 μ m to about 100 μ m to add tactile texture and matte finish appearance to the thermoplastic product and a frost colorant present in the thermoplastic product ranging from about 0.01 to about 15 parts by weight of thermoplastic resin, wherein the frost colorant comprises light-diffusing particles to add diffused translucency to the thermoplastic product.

The Examiner relies on the following prior art reference in rejecting the appealed claims:

Akao

5,384,173

Jan. 24, 1995

Claims 1-4, 8-10, 13, and 16-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Akao. Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Akao.

We reverse the stated rejections for reasons set forth in the Appeal Brief. The Examiner has not discharged the burden of presenting a *prima facie* case of anticipation and/or obviousness. In this regard, "the Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

All of the appealed claims require a molded thermoplastic product having an outer surface with a matte finish having an etched pattern including depressions ranging from about 0.1 micron about 100 microns (Claim 1).

Concerning the claimed molded product outer surface finish limitations of claim 1, the Examiner premises the tendered anticipation rejection of claim 1, as well as the lack of novelty rejection of dependent claims 2-4, 8-10, 13, and 16-18, on the Examiner's view that the claimed product molded outer surface reads on an inside surface of the molded container of Akao.

In this regard, the Examiner maintains that the roughened surface of an inside peripheral wall of the container of Akao provides a description of a molded product outer surface having a matte finish, as called for in the appealed claims (Ans. 3-4; Akao, col. 1, ll. 49-52, col. 2, ll. 39-56, col. 25, ll. 38-41; Fig. 2, inner surface 4). The Examiner reasons that "the inner wall of the container is still an outer surface" (Ans. 5.)

The Examiner states: "[t]he container of Akao has two outer most surfaces, one that forms the outer wall and one that forms the inner wall." *Id.*

The Examiner does not employ any of Akao's teachings with respect to the described container's inner wall (surface) (see generally Ans.). Rather, the Examiner asserts "[t]he fact that Akao uses the matte finish surface as the inner wall of a container does not diminish the fact the inner wall of the container is still an outer surface." *Id.*

Appellants, on the other hand, argue that (Br. 7):

Appellant invented a molded thermoplastic product which employs both the frost colorant in the form of light-diffusing particles and an etched pattern to add tactile texture and a matte finish appearance to the outer surface of the molded thermoplastic product. Appellant is entitled to allowance of his claims on appeal.

The Office has refused to see the distinction between an inner peripheral wall portion of Patent '173 and an outer surface of a molded thermoplastic product. In doing so, the Office gives no weight to the word outer as an adjective for surface.

Appellant does not dispute that "roughened face" 4 of container 1 of Patent '173 is a surface. But it most assuredly is NOT an outer one. Otherwise, where is the inner surface of container 1 of Patent '173? Inside the bulk of the body 2 of container 1? Then, it is no longer a surface at all.

The Office has not given ANY weight to the modifier "outer" as a locator for that portion of the surface upon which Appellant has chosen to etch a pattern to create a tactile texture and a matte finish by physical technique.

Appellant does not need to describe what is done with his inner surface of the molded thermoplastic article, because he does not care about that surface. He cares about the outer surface, the one which consumers pick up and handle on the grocery store shelf. It is the outer surface upon which the etched pattern is made that matters, because that outside surface, not the inside of the shampoo bottle, is the surface which the consumer grabs up in the wet shower stall. The Office has ignored the claim limitation about tactile texture entirely.

On this appeal record, we agree with Appellants. The Examiner's claim construction is unreasonably broad in reading the claim 1 molded thermoplastic product outer surface on the inner surface 4 (fig. 2) of the molded container of Akao. When the contested appealed claim term "outer surface is given its broadest reasonable interpretation in context and as it would be interpreted by an ordinarily skilled artisan when read in light of the Specification, it is clear that the claimed molded product outer surface pertains to a molded product surface that is an outer surface that is readily visible in use and/or on display. The Examiner has not established that this can be said of the inner peripheral wall surface 4 of the container body of Akao.

In light of the above, we need not discuss the other argued limitations that are asserted as establishing novelty for the subject matter embraced by the anticipatorily rejected claims.

On this appeal record, we reverse the Examiner's anticipation rejection.

Given that the Examiner's obviousness rejection of dependent claim 15 is predicated on the Examiner's misapplication of Akao's inner surface of a container peripheral wall to the claimed outer surface in the anticipation rejection of claim 1 (Ans. 4), we reverse the Examiner's obviousness rejection on this appeal record.¹

¹ The Examiner did not apply the disclosures and/or any suggestions that may be found in Akao with respect to roughening the outer surface of the peripheral wall of Akao's container (see col. 2, ll. 62-66; col. 24, ll. 18-37; Examples 1, 4, 5, 8, 9, 10, and 11) in the rejections before us. For example, the obviousness rejection before us is not founded on Akao's disclosures of a roughened outer peripheral wall surface taken together with any other teachings or suggestions for forming Akao's container, when the container is

CONCLUSION/ORDER

The Examiner's decision to reject claims 1-4, 8-10, 13, and 16-18 under 35 U.S.C. § 102(b) as being anticipated by Akao; and, to reject claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Akao is reversed.

REVERSED

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made transparent (Akao; col. 3, ll. 20-35), with any particular selection of light shielding materials (Akao; col. 11, l. 45- col. 14, l. 14) in amounts for that selected light shielding material that would have been expected to provide diffused translucency to such a container, and wherein the rejection is accompanied by a reviewable rationale explaining why an ordinarily skilled artisan would have been prompted to make a combination of such particular selections from the disclosures of Akao.